

Remarks

35 U.S.C. § 103 Rejection of Claims

In the 23 August 2007 Office Action, claims 36 - 74 are rejected as being unpatentable over Marshall (US Patent 6,073,115) in view of Krishnaswamy (U.S. Patent 6,909,708). The Examiner has cited Marshall and Krishnaswamy as reference documents.

The Assignee respectfully traverses the § 103 rejections of claims 36 - 74 in two ways. First, by noting that the 23 August 2007 Office Action fails under both tests established by the Administrative Procedures Act. Second, by noting that the 23 August 2007 Office Action cites a combination of documents that fails to establish a prima facie case of obviousness. More specifically, the Office Action fails to establish a prima facie case of obviousness in at least four ways:

1. by citing a combination of documents that teach away from the proposed combination;
2. by citing a combination of documents fails to teach all of the claim limitations;
3. by citing a combination of documents fails to make the invention as a whole obvious, and
4. by citing a combination of documents that require a change in the principle of operation of each of the cited documents.

The Assignee also notes that there are still other ways in which all § 103 obviousness rejections in the 23 August 2007 Office Action for claims 36 - 74 can be traversed.

As discussed previously, the first way the cited combination of documents fails to establish a prima facie case of obviousness is that it cites a combination of documents that teach away from the proposed combination. MPEP § 2145 X.D.2 provides that: "it is improper to combine references where the references teach away from their combination." The cited documents teach away from the proposed combination in a number of ways including:

1. Incompatible system topologies. Marshall teaches the use of Dynamic Data Exchange (hereinafter, DDE) for obtaining data from other systems (Marshall C5, L50 - 60 and C11, L20 - 25). It is well known to those of average skill in

the art that DDE is a mechanism for linking two applications on the same computer together in order to exchange data (see Visual Automation) At the same time, Krishnaswamy teaches distributed data management (Krishnaswamy, C38, L47 - C39, L 68). More specifically, Krishnaswamy teaches that “data is stored at many locations simultaneously” using distributed databases (Krishnaswamy, C39, L 5 - 6). It clearly would be improper to combine an invention that teaches and relies on the data being present on a single computer with a system that teaches and relies on data being stored in distributed databases resident on many computers.

2. Incompatible data management. Marshall teaches the use of DDE (Marshall C5, L50 - 60 and C11, L20 - 25). It is well known to those of average skill in the art that DDE is a method for obtaining data on an item at a time basis usually by spreadsheet cell (see Visual Automation). At the same time Krishnaswamy teaches the use of distributed data storage which includes automated replication and synchronization in accordance with a common schema (Krishnasway, C39 L14 - 19). It clearly would be improper to combine an invention that teaches and relies on obtaining data one item at a time basis with an invention that teaches and relies on database level replication and synchronization.
3. Incompatible focus. Marshall teaches a virtual reality generator for abstract pheonomena (Marshall, Title). Marshall goes on to state that “the information displayed in (the) virtual reality world created by the present invention is abstract information about the real world that does not have a physical object equivalent in the real world (Marshall, Column 3, lines 49 – 54). At the same time, a primary use of the Krishnaswamy invention is “routing telephone calls, data and other multimedia information including video, audio and data.” (Krishnaswamy, Abstract). The information routed by Krishnaswamy all have physical object equivalents in the real world. It clearly would be improper to combine an invention that teaches the display of abstract information that does not have a physical object equivalent in the real world with a system for managing information related to entities with physical object equivalents in the real world.

As discussed previously, the second way the 23 August 2007 Office Action fails to establish the prima facie case of obviousness required to sustain § 103 rejections of claim

36 - 74 is that it fails to teach all the claim limitations. MPEP 2142 provides that in order to establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. As detailed below, the 23 August 2007 Office Action fails to meet all three of the criteria for establishing a prima facie case of obviousness for claims 36 - 74: The 23 August 2007 Office Action fails to meet the third criteria for establishing a prima facie case of obviousness because it does not teach or suggest one or more limitations for every claim.

Far from establishing a prima facie case of obviousness for claims 36 - 74, the cited combination of documents in the 23 August 2007 Office Action provides additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious. It does this by calling for a combination of documents when the cited documents teaches away from their proposed combination, by advocating a combination of documents that is an almost certain failure and by relying on a combination of documents that fails to suggest or make obvious almost all of the claim limitations.

The third way the combination of documents cited 23 August 2007 Office Action fails to establish a prima facie case of obviousness for claims 36 - 74 is that it fails to make the invention as a whole obvious as required by MPEP § 2141.02 which states that:

In determining the difference between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious but whether the claimed invention as a whole would have been obvious.

As noted previously, the obviousness rejections are based on a combination of Marshall and Krishnaswamy. Marshall and Krishnaswamy each teach away from the method of the instant application in a number of ways. As noted previously, the two documents also teach away from their own combination and the Examiner has failed to identify any possible reasons for combining the two inventions. Taken together the cited combination of documents fails to make the invention as a whole obvious. The cited combination also fails to make a single aspect of the claimed invention obvious. These failures provide additional evidence that the claimed invention for producing concrete, tangible and useful results is new, novel and non-obvious.

The fourth way the 23 August 2007 Office Action fails to establish a prima facie case of obviousness is that the proposed combination would change the principle of operation of

each of the cited documents. MPEP 2143.01 states that “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)”. The proposed combination would change the principle of operation of each document cited as a reference as described below:

1. Change from visualization of abstract phenomena to analysis of real world elements of value. Marshall teaches a virtual reality generator for abstract phenomena (Marshall, Title). Marshall goes on to state that “the information displayed in (the) virtual reality world created by the present invention is abstract information about the real world that does not have a physical object equivalent in the real world (Marshall, Column 3, lines 49 – 54). The Examiner has proposed using this invention in combination with Krishnaswamy to among other things render obvious an invention for identifying a tangible, real world impact of a plurality of real world elements of value including brands, customers and employees. Modifying Marshall to evaluate or analyze real world elements of value would require a change in principle in the operation of the Marshall invention. As a result, the teachings of the cited combination of documents are not sufficient to render the claims prima facie obvious.
2. Change from distributed data storage to centralized data storage. Krishnaswamy teaches distributed data management (Krishnaswamy, C38, L47 - C39, L 68). More specifically, Krishnaswamy teaches that “data is stored at many locations simultaneously” using distributed databases (Krishnaswamy, C39, L 5 - 6). The Examiner has proposed using this invention in combination with Marshall to among other things render obvious an invention for integrating data from a plurality of systems in accordance with a common xml schema and storing the integrated in a single application database. Modifying Krishnaswamy to rely on a single, centralized database would require a change in principle in the operation of the Krishnaswamy invention. As a result, the teachings of the cited combination of documents are not sufficient to render the claims prima facie obvious.
3. Change from inter-connected applications to independent software components. Marshall teaches the use of Dynamic Data Exchange (hereinafter, DDE) for obtaining data from other systems (Marshall C5, L50 - 60 and C11, L20 - 25). It is

well known to those of average skill in the art that DDE is a mechanism for linking two applications on the same computer together in order to exchange data (see Visual Automation). The Examiner has proposed using this invention in combination with Krishnaswamy to among other things render obvious an invention for using independent components for producing tangible, concrete and useful results. Modifying Marshall to use independent components instead of linked applications would require a change in principle in the operation of the Marshall invention. As a result, the teachings of the cited combination of documents are not sufficient to render the claims prima facie obvious.

The Assignee notes again that there are still other ways in which all §103 obviousness rejections in the 23 August 2007 Office Action for claims 36 – 74 can be traversed.

§101 rejections

In the 23 August 2007 Office Action, claims 36, 55, 64 and 70 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. More specifically the Examiner states that claims 36, 55, 64 and 70 appear to be directed to an abstract idea because they use the words integrating, developing, analyzing, developing and determining and that the claims lack utility as they fail to define a tangible, concrete and useful result. These rejections are respectfully traversed by in two ways. First, by noting that the Examiner has failed to establish a prima facie case that any of the claims are directed to non-statutory subject matter and/or lack utility. Second, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot.

The first reason claim 36, 55, 64 and 70 are patentable is that the 23 August 2007 Office Action fails to establish a prima facie case of non-statutory subject matter and a lack of utility for the rejected claims. It is well established that *"the examiner bears the initial burden ... of presenting a prima facie case of unpatentability."* *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). MPEP 2164.07 states *"the examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility."* *In re Swartz*, 232 F.3d 862, 863, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000); *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)). Given the complete absence of evidence, the Assignee respectfully submits that it is obvious that the Examiner has failed to establish the required prima facie cause of non-statutory subject matter and the related a lack of utility for the rejected claims.

As stated previously, the second way the Assignee will respectfully traverse the rejection of claims 36, 55, 64 and 70 will be by noting that every one of the claim rejections are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of USPTO findings are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Supreme Court has stated that *"substantial evidence*

is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. . . Mere uncorroborated hearsay or rumor does not constitute substantial evidence. Consolidated, 305 U.S. at 229-30 (citations omitted)". The Assignee respectfully submits that the instant Office Action fails to provide even a scintilla of evidence to support the allegation of non statutory subject matter and lack of utility it contains and that as a result it fails to meet the substantial evidence standard.

The Assignee respectfully submits that the 23 August 2007 Office Action also fails to pass the arbitrary and capricious test. In the Gartside decision (In re Gartside 203F.3d 1305, 53 U.S.P.Q2d 1769 (Fed Circuit 2000)) the First Federal Circuit discussed the arbitrary and capricious standard when it noted: *Because this standard is generally considered to be the most deferential of the APA standards of review, (see Stein et al., Administrative Law 51.03, at 51-117 (1999)) the reviewing court analyzes only whether a rational connection exists between the agency's fact findings and its ultimate action, (see Hyundai Elecs. Indus. Co. v. ITC, 899 F.2d 1204, 1209, 14 USPQ2d 1396, 1400 (Fed. Cir. 1990).* The Assignee respectfully submits that the 23 August 2007 Office Action also fails to pass the arbitrary and capricious test for a number of reasons including: the Examiner has not completed any discernible fact finding that can be rationally or irrationally connected to the rejections contained in the Office Action. Furthermore, the U.S.P.T.O. prior fact findings have found the completion of the same or similar tasks to be statutory. Examples are provided in the concurrently filed Information Disclosure Statement. The Assignee notes that there are a number of other ways to traverse these rejections.

The uncertainty created by these arbitrary, capricious and discriminatory attempts to reject the claims in the instant application and related applications under §101 while granting patents for similar inventions to large companies has caused considerable damage to the Assignee.

35 U.S.C. § 112 Second Paragraph Rejection of Claims

In the 23 August 2007 Office Action the Examiner has rejected claims 36, 55, 64 and 70 are rejected under 35 U.S.C. §112 second paragraph. In particular, the Examiner feels that the phrases “enterprise related transaction data”, “at least some data”, “net relative contribution” and “at least a portion of the data” used alone and in various combinations renders the claims that incorporate them indefinite. The Assignee will respectfully traverse the §112 second paragraph rejections of each claim in several ways.

1. by noting that the Office Action has failed to establish a prima facie case that the claims do not meet the requirements of §112 second paragraph;
2. by noting that the claim rejections based on assertions of alleged indefiniteness are not in compliance with the Administrative Procedures Act and are therefore moot; and
3. by noting that the meaning of the questioned terms are well known to those of average skill in the art.

The first way the Assignee will traverse the 35 U.S.C. §112 second paragraph rejection of claims 36, 55, 64 and 70 will be by noting that the arguments presented by the Examiner fail to establish the prima facie case required to sustain a §112 second paragraph rejection. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

- (A) *The content of the particular application disclosure;*
- (B) *The teachings of the prior art; and*
- (C) *The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.*

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001). In the case of claims 93 – 130 the Examiner has failed to establish

the prima facie case that the specification does not meet the requirements of §112 second paragraph in five ways for every rejected claim. The five ways are: by failing to interpret the claims in light of the specification, failing to interpret the claims in light of the prior art, by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims, by failing to establish that the limitation(s) in the claims fail to describe the invention and/or by failing to consider the claim as a whole.

As noted previously, the second way the Assignee will respectfully traverse the §112 second paragraph rejections of claims 36, 55, 64 and 70 is by noting that the assertions regarding the alleged indefiniteness of the claims are not in compliance with the requirements of the Administrative Procedures Act and are therefore moot. In *Dickinson v. Zurko*, 119 S. Ct. 1816, 50 USPQ2d 1930 (1999), the Supreme Court held that the appropriate standard of review of PTO findings are the standards set forth in the Administrative Procedure Act ("APA") at 5 U.S.C. 706 (1994). The APA provides two standards for review – an arbitrary and capricious standard and a substantial evidence standard. The Assignee respectfully submits that discussion in the preceding paragraphs clearly shows that the instant Office Action fails to provide even a scintilla of evidence to support the allegation that the specification does not meet the requirements of §112 second paragraph and that as a result it fails to meet the substantial evidence standard. In particular, the Assignee notes that the 23 August 2007 Office Action does not contain any declarations from individuals with the requisite skill in the art to support the assertions regarding the claims. The Assignee respectfully submits that the 23 August 2007 Office Action also fails to pass the arbitrary and capricious test because the Examiner has not provided any evidence of relevant fact finding that rationally or irrationally can be connected to the rejections contained in the Office Action. The Assignee notes that there are still other ways in which these rejections can be shown to be arbitrary, capricious and discriminatory.

The third way the Assignee will traverse the §112 second paragraph rejections of claims 36, 55, 64 and 70 is by noting that the cited terms are well known by those of average skill in the art and that it would be unlikely that their use would cause any confusion on the part of those will possess average skill in the art and that others have been allowed to the use the same or similar terms.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. 37 CFR 1.111 states in part that:

In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections.

The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons a few claims were amended was to correct clerical errors and to put the claims into final form for allowance and issue.

Information Disclosure Statements

The Assignee respectfully requests that copies of all previously submitted information disclosure statement forms be initialed and returned as soon as possible.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is respectfully requested.

Respectfully submitted,

/B.J. Bennett/

B.J. Bennett, President Asset Trust, Inc.

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